

**REMARKS**

Claims 1-63 remain in this application. Claims 1-4, 8-11, 33-38, 41, 45-47 and 49-62 are rejected. Claims 5-7, 12-32, 39, 40, 42-44, 48 and 63 are objected to. Claims 2, 4, 5, 12-14, 16-19, 30, 31, 37-40, 42, 48, 54 and 63 are amended herein to express the invention in alternative wording and to address matters of form unrelated to substantive patentability issues. For example, reference numerals are removed as the elements of the claims are not considered limited to specific corresponding structures in the drawings. Other formal matters are attended to that were not addressed by the Examiner and accordingly are considered unrelated to substantive patentability issues.

Applicants herein traverse and respectfully request reconsideration of the rejection of the claims and objections cited in the above-referenced Office Action.

Claims 4, 37, 39, 40 and 54 are objected to for noted informalities. The claims are amended and correct the informalities. Therefore, withdrawal of the objection is earnestly solicited.

Claims 1-4, 8, 9, 33, 34, 38, 41, 45, 46, 49, 50-55, 58, 59 and 62 are rejected as obvious over Morgan et al. (US 5,040,362) in view of Jauss (US 3,894,382), Quick (US 3,462,927) and Smith (US 822,395) under 35 U.S.C. §103(a). The applicants herein respectfully traverse this rejection. For a rejection under 35 U.S.C.

§103(a) to be sustained, the differences between the features of the combined references and the present invention must be obvious to one skilled in the art.

With regard to the claimed subject matter of independent claim 1, the Office Action admits that Morgan does not disclose that the cutting plane, which is formed by outwardly protruding cutting means, forms part of the endless conveyor, and that an essentially closed front surface is provided for the chain elements. Consequently, Jauss is cited in an attempt to supplement the lacking disclosure in Morgan. However, in this regard, applicants note that the element designated by the numeral 6, averred by the Examiner to represent cutting means which are a component of a revolving chain, are in fact clamping flanges and do not fulfill any cutting function. Rather, cutting is carried out by the cutting disk 17.

Furthermore, the Office Action relies upon Quick, in connection with which it is the Examiner's stated position that a harvesting mechanism is allegedly disclosed, for which the space between the cutting planes is closed. Applicants respectfully submit that this does not accurately reflect the disclosed invention, since the elements 30 and 31 are gathering devices, whereas the cutting process is, in actuality, carried out instead by the cutting disk 10.

Reference in the Office Action is additionally made to Smith, wherein the Examiner avers that the providing of closed chain elements is known from this patent. However, while the disclosed chain elements (links) 12 may arguably offer a "closed surface", such closed surface is provided only in connection with a dipper

dredger chain, the chain elements of which carry closed scoop parts 16, with which a closed accommodation space is to be formed exclusively for excavation purposes.

Applicants respectfully argue that the alleged “closed” area of the chain elements 12 of Smith fulfils a function completely different from that of the inventive conveying chain. Consequently, one of ordinary skill in the art would not be likely to look at the field to which the Smith reference belongs. It is applicants’ position that there is no inducement whatsoever to select individual distinguishing features disclosed in any of the publications cited, and to transfer them to a construction, such as that represented, for example, by Morgan.

In order to rely on a reference as a basis for rejection of the applicants’ invention, the reference must either be in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. *See In re Deminski*, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986). “Patent examination is necessarily conducted by hindsight, with complete knowledge of the applicant's invention, and the courts have recognized the subjective aspects of determining whether an inventor would reasonably be motivated to go to the field in which the examiner found the reference, in order to solve the problem confronting the inventor. We have reminded ourselves and the PTO that it is necessary to consider ‘the reality of the circumstances’” *In re Wood*, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979).

Furthermore, it is improper as a matter of law to use the claims presented as a blueprint to combine prior art references. *Ashland oil, Inc. v. Delta Resins & Refractories, Inc.* , 227 USPQ 657, 667 (CAFC 1985). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. *Carela v. Starlight Archery*, 231 U.S.P.Q. 644 (Fed. Cir. 1986). In this regard, it is respectfully submitted that no motivation to combine the references cited in the rejection is herein present.

Thus, it is respectfully submitted that the rejected claims are not obvious in view of the cited references for the reasons stated above. Reconsideration of the rejections of claims 1-4, 8, 9, 33, 34, 38, 41, 45, 46, 49, 50-55, 58, 59 and 62 and their allowance are respectfully requested.

Claims 10 and 11 are rejected as obvious over Morgan et al. in view of Jauss, Quick and Smith, and further in view of Bertling (US 5,237,804) under 35 U.S.C. §103(a).

It is respectfully submitted that the proffered combination of references cannot render the rejected claims obvious because the Bertling reference does not provide the teaching noted above with respect to the obviousness rejection of claim 1, from which the rejected claims depend, that is absent from the Morgan et al., Jauss, Quick and Smith references. Thus, the combination of prior art references

fails to teach or suggest all the claim limitations. Therefore, reconsideration of the rejections of claims 10 and 11 and their allowance are respectfully requested.

Claims 35-37 are rejected as obvious over Morgan et al. in view of Jauss, Quick and Smith, and further in view of Olinger (US 5,875,624) under 35 U.S.C. §103(a).

It is respectfully submitted that the proffered combination of references cannot render the rejected claims obvious because the Olinger reference does not provide the teaching noted above with respect to the obviousness rejection of claim 1, from which the rejected claims depend, that is absent from the Morgan et al., Jauss, Quick and Smith references. Thus, the combination of prior art references fails to teach or suggest all the claim limitations. Therefore, reconsideration of the rejections of claims 35-37 and their allowance are respectfully requested.

Claim 47 is rejected as obvious over Morgan et al. in view of Jauss, Quick and Smith, and further in view of Krone et al. (US 4,771,592) under 35 U.S.C. §103(a).

It is respectfully submitted that the proffered combination of references cannot render the rejected claims obvious because the Krone reference does not provide the teaching noted above with respect to the obviousness rejection of claim 1, from which the rejected claim depends, that is absent from the Morgan et al., Jauss, Quick and Smith references. Thus, the combination of prior art references

fails to teach or suggest all the claim limitations. Therefore, reconsideration of the rejections of claim 47 and its allowance are respectfully requested.

Claims 56, 57, 60 and 61 are rejected as obvious over Morgan et al. in view of Jauss, Quick and Smith, and further in view of Van Amstel (EP 0 541 173 A1) under 35 U.S.C. §103(a).

It is respectfully submitted that the proffered combination of references cannot render the rejected claims obvious because the Van Amstel reference does not provide the teaching noted above with respect to the obviousness rejection of claim 1, from which the rejected claims depend, that is absent from the Morgan et al., Jauss, Quick and Smith references. Thus, the combination of prior art references fails to teach or suggest all the claim limitations. Therefore, reconsideration of the rejections of claims 56, 57, 60 and 61 and their allowance are respectfully requested.

Claims 5-7, 12-32, 39, 40, 42-44, 48 and 63 are objected to as being dependent from rejected base claims. The Examiner indicates that the claims contain allowable subject matter and would be allowed if put in independent form incorporating the limitations of the base and intervening claims. The claims are amended in accordance with the Examiner's suggestion and to clarify the subject matter of the present invention. Claims 5, 12-14, 16-19, 30, 31, 39, 40, 42, 48 and 63 are placed in independent form with the remaining objected to claims being dependent from respective ones thereof. Reconsideration of the objection and allowance of the claims are respectfully requested.

Thirteen (13) further independent claims in excess of three are added. Accordingly, please charge the fee of \$1118 to Deposit Account No. 10-1250.

Applicants respectfully request a one (1) month extension of time for responding to the Office Action. Please charge the fee of \$110 for the extension of time to Deposit Account No. 10-1250.

In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited. Please charge any deficiency or credit any overpayment to Deposit Account No. 10-1250.

Respectfully submitted,  
JORDAN AND HAMBURG LLP

By Frank J. Jordan  
Frank J. Jordan  
Reg. No. 20,456  
Attorney for Applicants

Jordan and Hamburg LLP  
122 East 42nd Street  
New York, New York 10168  
(212) 986-2340

James J. O'Neil  
Reg No. 36,049